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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,852	12/11/2000	Hyun-Jeong Kim	678-578 (P9616)	4736
28249	7590	05/05/2005	EXAMINER	
DILWORTH & BARRESE, LLP 333 EARLE OVINGTON BLVD. UNIONDALE, NY 11553			LY, NGHI H	
			ART UNIT	PAPER NUMBER
			2686	
DATE MAILED: 05/05/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/734,852

**Applicant(s)**

KIM, HYUN-JEONG

**Examiner**

Nghi H. Ly

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 16-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 21-25 are rejected under 35 U.S.C. 102(e) as being anticipated by John (US 6,216,106).

Regarding claim 21, John teaches a method of communicating a confirmation message (see Abstract, see column 4, lines 41-49 and see column 7, lines 39-44), comprising the steps of: determining, when a voice call is not normally established between a called mobile station and a calling mobile station (see column 3, lines 8-9, "If calling party tries to call the mobile subscriber when not available"), if a called party of the called mobile station has confirmed a message created and transmitted by the calling mobile station (see Abstract, column 5, lines 33-36, column 6, lines 30-40 and column 7, lines 39-45), generating, by the called mobile station, a confirmation message indicating the confirmation by the called party (see Abstract, column 5, lines 33-36, column 6, lines 30-40 and column 7, lines 39-45), and transmitting, from the called mobile station, the confirmation message to the calling mobile station (see Abstract, column 5, lines 33-36, column 6, lines 30-40 and column 7, lines 39-45).

Regarding claim 22, John further teaches the message is a voice message (see Abstract).

Regarding claim 23, the combination of John further teaches the message transmitted by the calling mobile station is a text message (column 1, lines 34-55, see "electronic mail" and it reads on Applicant's "text message").

Regarding claim 24, John further teaches the confirmation message is a data burst message (see column 5, lines 10-35, "play", "delete", "played" and "unplayed" and see column 7, lines 39-45 and column 6, lines 34-36).

Regarding claim 25, John further teaches the confirmation message is a short message (see column 5, lines 10-35, "play", "delete", "played" and "unplayed").

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 16-19 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over John (US 6,216,106) in view of Choksi et al (US 6,477,243).

Regarding claim 16, John teaches a method of communication a confirmation message (see Abstract, see column 4, lines 41-49 and see column 7, lines 39-44), comprising the steps of: informing a called mobile station of receipt of a message from a

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calling mobile station (see Abstract, see column 4, lines 41-49 and see column 7, lines 39-44), determining, if the received message is a text message (column 1, lines 34-55, see "electronic mail" and it reads on Applicant's "text message") if a called party of the called mobile station has confirmed the received message (see Abstract, see column 5, lines 33-36), which is stores in the called mobile station (se column 1, lines 22-23), and transmitting, from the called mobile station (see Abstract, column 4, lines 41-49 and column 7, lines 39-44), a confirmation message to be delivered to the calling mobile station (see Abstract, see column 4, lines 41-49 and see column 7, lines 39-44), wherein the confirmation message is generated by the called mobile station when the called mobile station has confirmed the received message (see Abstract, column 5, lines 33-36, column 6, lines 30-40 and column 7, lines 39-45).

John does not specifically disclose the confirmation message includes a telephone number of the calling mobile station.

Choksi teaches the confirmation message includes a telephone number of the calling mobile station (see column 9, lines 43-55).

Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention was made to provide the above teaching of Choksi into the system John so that a notification can be received by a particular user.

Regarding claim 17, John further teaches the step of determining, if the received message is a voice message (see column 6, lines 30-41 and see column 7, lines 39-45), whether the called mobile station is connected to a voice mail center in order to confirm the received voice message (see Abstract).

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Regarding claim 18, John further teaches the confirmation message is a data burst message (see column 5, lines 10-35, "play", "delete", "played" and "unplayed" and see column 7, lines 39-45 and column 6, lines 34-36).

Regarding claim 19, John further teaches the confirmation message is a short message (see column 5, lines 10-35, "play", "delete", "played" and "unplayed").

Regarding claim 27, John teaches claim 21, John does not specifically disclose the confirmation message includes a telephone number of the calling mobile station.

Choksi teaches the confirmation message includes a telephone number of the calling mobile station (see column 9, lines 43-55).

Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention was made to provide the above teaching of Choksi into the system John so that a notification can be received by a particular user.

5. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over John (US 6,216,106) in view of Choksi et al (US 6,477,243) and further in view of DeGiorgio et al (US 3,866,206).

Regarding claim 20, the combination of John and Choksi teaches displaying, in the calling mobile station (see John, column 7, lines 39-45, see "displaying alphanumeric message"), information indicating receipt of the confirmation message, upon receipt of the confirmation message (also, see John, column 7, lines 39-45, see "displaying alphanumeric message"). The combination of John and Choksi does not specifically disclose sounding an alarm upon receipt of the confirmation message.

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DeGiorgio teaches sounding an alarm upon receipt of the confirmation message (see column 9, lines 64-68 and see fig.5, beeper 156).

Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention was made to provide the above teaching of DeGiorgio into the system John and Choksi so that the sender can response to the alarm faster.

6. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over John (US 6,216,106) in view of DeGiorgio et al (US 3,866,206).

Regarding claim 26, teaches displaying, in the calling mobile station (see John, column 7, lines 39-45, see "displaying alphanumeric message"), information indicating receipt of the confirmation message, upon receipt of the confirmation message (also, see John, column 7, lines 39-45, see "displaying alphanumeric message"). The combination of John and Choksi does not specifically disclose sounding an alarm upon receipt of the confirmation message.

DeGiorgio teaches sounding an alarm upon receipt of the confirmation message (see column 9, lines 64-68 and see fig.5, beeper 156).

Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention was made to provide the above teaching of DeGiorgio into the system John so that the sender can response to the alarm faster.

***Response to Arguments***

7. Applicant's arguments filed 01/07/2005 have been fully considered but they are not persuasive.

On page 5 of Applicant's remarks, Applicant argues that John, Choksi or DeGiorgio does not teach sending a confirmation for a text message.

The Examiner, however, disagrees. John does indeed teach sending a confirmation for a text message (column 1, lines 34-55, see "electronic mail" and it reads on Applicant's "text message").

On page 6 of Applicant's remarks, Applicant further argues that John, Choksi or any secondary reference does not teach generating and transmitting, by the called mobile station, a confirmation message indicating the confirmation by the called party to the calling mobile station.

The Examiner, however, disagrees. John does indeed teach Applicant's claimed limitation (see Abstract, column 5, lines 33-36, column 6, lines 30-40 and column 7, lines 39-45).

In addition, Applicant's attention is directed to the rejection of claims 16 and 21 above.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (703) 605-5164. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic  
Business Center (EBC) at 866-217-9197 (toll-free).

Nghi H. Ly

*cds*  
*04/19/05*

*Rafael Perez-Gutierrez*  
**RAFAEL PEREZ-GUTIERREZ**  
**PATENT EXAMINER**  
*4/28/05*